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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/769,656 | 01/25/2001 | Wayne McElhaney JR. | 629 | 3470 |

7590

09/13/2002

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EXAMINER

TRAN, KHOA H

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,656

Applicant(s)

MCELHANEY, WAYNE

Examiner

Khoa Tran

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

The drawings are stand objected to under 37 CFR 1.83(a) as aforementioned in Paper No. 03. Note, the drawings must show every feature of the invention specified in the claims. Therefore, the "hooks are laterally adjustable in size" in claim 5, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 1, there is no antecedent basis for "said support means", lines 8-9. Further, the recitation of various "means" beginning line 10 is no more than a catalog of elements that fails to properly include the necessary structural cooperative relationship. With respect to claim 3, there is no antecedent basis for "said support means", line 5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckley. It should be noted that the claims are of such breadth that they read on the hanging storage container for a ladder of Buckley. It should be noted that the claims need only to "read on" something in the prior art for anticipation to exist.

Buckley discloses a storage container comprising:

a storage volume (102) formed by a plurality of vertical sidewalls connected to a bottom and having an articulated lid (118), see Figure 1;

an adjustable attachment means of a hook (404) connects to and extending cantilever outward from a supporting means (408) and a lateral supporting plate (402);

a support means (112) for supporting a pneumatic driving tool;

a support means (116) for supporting tools;

a support means (106, 104) for supporting cups;

a support means (110) for supporting rags; and

a slidable storage drawer (200) is provided along the lower surface of the storage container, thereby allowing for additional storage for small items.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Walker. The claim is of such breadth that it reads on the hanging storage box of Walker.

Walker discloses a cantilever hanging box comprising a storage volume box (10) having a lockable lid (44), an adjustable attachment means of padding material (felt, foam rubber (40)) for mounting to support arms (the vertical side arms that are connected to a member (34)), and wherein the inside volume of the box providing

support means for supporting articles such as tools, cups, rags, and pneumatic driving tools, or the like. See Figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley as applied to claims 1 and 2 above, and further in view of McGarrah. McGarrah teaches a storage container having a pair of adjustable hooks (16) and a lockable lid (24). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the lid of Buckley with a lockable lid and it would have been obvious to one of ordinary skill in the art to make duplication in part to provide the storage container of Buckley with the provision of a pair of adjustable hooks as taught by Walker in order to have a lid that is lockable to prevent theft to the articles store inside the container and the pair of hooks is to further secure the storage to a support thus producing no unexpected results.

Claims 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley in view of McGarrah as applied to claims 1-4, 6 and 10 above, and further in view of Hall. Hall teaches a notoriously old and well-known per se of the laterally adjusting hook (12) that adjusts by a threaded screw (50) and a wing nut (52) and a lateral extending plate (20) extending from the container having various sizes of

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openings (26). See Figures 2 and 4. Considering the disclosure of Buckley and the teaching of McGarrah and Hall, taken as a whole, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the lateral support plate of Buckley with the provision of various sizes of openings as taught by Hall in order to store items therein the openings and it would have been obvious to one of ordinary skill in the art to modify the modified hooks of Buckley with the provision of hooks that are laterally adjustable as taught by Hall in order to have the hook adjusting laterally according to the size of the supporting means because it is well within the level of skill of one of ordinary skill to utilize known features of the art for the purpose that they are known. Further, it is expected as a part of the level of one of ordinary skill to discover the optimum or workable ranges of the adjusting size of the hook for a particular use. Accordingly, it would have been an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill in the art to discover and dimensions the workable range of the adjustable support hook to be between 3 inches to 5-1/2 inches for its intended use, thus producing no new and unexpected results.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedrow in view of Kilmas. Tedrow discloses a toolbox organizer comprising a storage volume with a lockable lid (14), a lateral support plate (26) with various sizes of apertures thereon extending horizontally from the storage volume for supporting tools. See Figures 1-4. Kilmas teaches a toolbox having a pair of laterally adjustable hooks (11). It would have been obvious to one of ordinary skill in the art to provide the toolbox

of Tedrow with the provision of adjustable hooks as taught by Kilmas in order to enable the toolbox to hang from a horizontal member of a scaffold or the like. With respect to the dimensioning in claim 5, it is expected as a part of the level of one of ordinary skill to discover the optimum or workable ranges of the adjusting size of the hook for a particular use. Accordingly, it would have been an obvious matter of engineering design choice, as determined through routine experimentation and optimization, for one of ordinary skill in the art to discover and dimensions the workable range of the adjustable support hook to be between 3 inches to 5-1/2 inches for it intended use, thus producing no new and unexpected results.

Claims 1 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedrow in view of Klimas as applied to claims 3-6 above, and further in view of Yemini. Yemini teaches a plurality of different sizes of apertures on the supporting plate to accommodate different sizes of tools or articles. See Figure 1. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the tool supporting plate of Tedrow with the provision of tool supporting plate that has various of large and small sizes of apertures as taught by Yemini in order to have the support plate that can support various of hardware articles including supporting electrical items therefrom the plate because it is well-within the level of skill in the art to utilize the known features of the art for the purpose for which they are known

Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedrow in view of Klimas as applied to claims 3-6 above, and further in view of Richards. Richards teaches a slidably storage drawer (36 and 42) provides along a

lower surface of the toolbox. See Figures 1 and 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the toolbox of Tedrow with the provision of a slidably retained drawer as taught by Richards in order to have an extra storage compartment for storage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jantzen, Bicker et al., and Hart, Jr. are cited to show devices having similar configurations of design.

Response to Arguments

Applicant's arguments filed June 14, 2002 have been fully considered but they are not persuasive.

With respect to the Section 112 rejection, it is noted that claim 1 still recites numerous "means" as a catalog of elements and changes in terminology by applicant have not been made throughout all claims.

With respect to applicant's remarks regarding Buckley, applicant is correct that compartment 112 of Buckley can "store conceivably anything". However, that is exactly the point. What specific claim language precludes this compartment from being the one in question? Patentability is based on the specific structure of the device, not how one intends to use it. Accordingly, it appears the applicant is relying upon the specification to impart the claims limitations that otherwise not recited therein. This reliance is ineffective.

With respect to applicant's remark about the pneumatic tool support means being "more of a loop shape" and not a storage compartment, where is this recited in the

claimed? The recitation of a "means", while encompassing a loop, does not preclude a storage compartment. Note that patentability is based on the language of the claims and not the disclosure of the specification.

Applicant's remarks for both Buckley and Walker regarding an external support are not commensurate with the scope of the claims. Nowhere in either claim 1 or 3 is there a requirement for a support external to the main containment volume. Accordingly, this argument has not been considered further.

Applicant's remarks comparing the tray of Buckley with the disclosed drawer of the instant invention are acknowledged. However, once again it is not seen where the claim recites the features that applicant wishes to rely on.

With respect to walker and claim 3, note the previous comments above. Further, applicant should note that claim 3 is of such breath that it recites nothing more than a box with a support. Once again, applicant is attempting to read more into the claim than has been actually set forth. For example, applicant refers to "supporting tools" and "an unorganizedness". Where in claim 3 is it set forth that any of the three recited elements is for supporting tools? Figure 2 of Walker does not show the items stored therein to be in an "unorganizedness" so what is the basis for the applicant's position? It is well-settled that it is the language of the claims that determine patentability. Accordingly, which limitation, as currently set forth by claim 3, is missing from Walker? It is strongly suggested that applicant amend the language of the claims to particularly define the limitations/features actually being desired.

Applicant's arguments on page 6 with respect to McGarrah and Hall, are noted. However, the rejections are based on a combination of references and it is ineffective to attack each reference individually. Further, McGarrah and Hall have been applied for their respective teachings and there is no requirement for a secondary reference to meet every limitation of the claim before it can be utilized.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437. The examiner can normally be reached on Monday through Thursday from 9:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate

of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

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Khoa Tran

September 03, 2002



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